

REMARKS

This application has been reviewed in light of the Office Action dated September 7, 2006. Claims 1, 2, 4-10, and 12-15 are presented for examination, of which Claims 1, 10, and 14 are independent. Claims 3, 11, and 16 have been cancelled without prejudice or disclaimer. Claims 1, 2, 4-10, and 12-15 have been amended to define more clearly what Applicants regard as the invention. Claims 17-19 have been added to provide Applicants with a more complete scope of protection. The claim amendments are further discussed below. Favorable reconsideration is respectfully requested.

Initially, in response to the Examiner's objection to the Information Disclosure Statements filed on May 2, 2005 and March 19, 2004, Applicants have filed a Supplemental Information Disclosure Statement on February 5, 2007, along with copies of the cited references, in accordance with 37 C.F.R. § 1.98(a)(2). It is respectfully requested that the information contained therein be considered, and that the Examiner acknowledge the consideration of such information.

In addition, as reflected in the Office Action Summary, the Examiner acknowledged the receipt of the drawings filed on March 10, 2004. However, the Examiner did not indicate whether he accepted or objected to the drawings. Applicants presumed that the drawings were accepted by the Examiner.

Claim Rejections Under 35 U.S.C. § 101

Claims 1-16 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner stated that the claims are not directed towards a

final result that is useful, tangible, and concrete. The Examiner requested that limitations of the practical application, result, and concrete, useful, and tangible final result be included in the claim. The Examiner further stated that since the practical application, result, concrete, useful and tangible limitations are not claimed in Claims 1, 10, and 14, such claims are deemed non-statutory. Applicants respectfully traverse.

To meet the requirements of 35 U.S.C. § 101, "[t]he claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a 'useful, concrete and tangible result.'" M.P.E.P. § 2106(II)(A) (quoting *State Street Bank & Trust v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998)).

1 The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility ("Interim Guidelines") provides the following example of a claimed invention that produces a useful, concrete, and tangible result:

"[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601.

Interim Guidelines, page 39.

Claim 1 recites a method for adding a plurality of data sets onto a radio frequency transaction device. The method includes the steps of adding to the RF transaction device database, a first data set of a first format, wherein the first data set is

owned by the first data set owner, and adding to the RF transaction device database, a second data set of a second format, wherein the second data set is owned by the second data set owner, the first data set owner is distinct from the second data set owner, and the first format is different from the second format, wherein the first data set is stored in accordance with the first format, and the second data set is stored in accordance with the second format. The method also includes the step of adding a condition header to at least one of the first and second data sets, the condition header identifies a status condition of the at least one of the first and second data sets. Claims 10 and 14 similarly recite these features.

It is respectfully submitted that if "transformation of data. . .into a final share price" is statutory subject matter, then the claimed steps of adding data sets in a RF transaction device and adding a condition header to at lease one of the data sets also is statutory, because these steps produce a "useful, concrete and tangible result", *i.e.*, an RF transaction device having at least 2 different data sets in different formats. Thus, Claims 1, 10, and 14 are believed to be directed to statutory subject matter.

Nevertheless, to further emphasize the useful, concrete, and tangible results of the invention, Claim 1 has been amended to recite that the RF transaction device is configured to facilitate performing a financial transaction. Support for this amendment may be found, for example, in the specification in paragraphs [0035] and [0054]. Claims 10 and 14 have been similarly amended.

1 The claimed invention must produce a useful, concrete and tangible result; however, the utility of the claimed invention need not be recited in the claims.

Accordingly, Applicants submit that Claims 1, 10, and 14 meet the requirements of 35 U.S.C. § 101, and withdrawal of this rejection is respectfully requested.

Double Patenting Rejections

Claims 1-16 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-24 of copending Application No. 10/708,585 and as being unpatentable over Claims 12-35 of copending Application No. 10/709,815.

In order to advance the prosecution of the present application and issuance of the claims, Applicants will file a terminal disclaimer should the claims be deemed allowable.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-16 were rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Specifically, the Examiner stated that the recitation of the phrase “transaction device database” in Claim 1 renders the claim indefinite because it is not clear if the transaction device database is the database of the RF transaction device. Claim 1 has been amended to recite “RF transaction device database”. Applicants believe that the amendment to Claim 1 overcomes this rejection and therefore, respectfully request that this claim rejection be withdrawn.

With respect to Claim 10, the Examiner stated that the phrase “the transaction device including, a data storage area …” recited at the beginning of the claim and the phrase “transaction device” recited at the end of the claim render the claim indefinite because it is not clear whether or not the first and second transaction device storage areas are databases of the RF transaction device. Claim 10 has been amended to recite “said RF transaction device comprising: a first data storage area … and a second data storage area” Accordingly, Applicants submit that the grounds of rejection has been obviated and respectfully request that this claim rejection be withdrawn.

Claim 14 was rejected as being indefinite due to the recitation of “transaction device” and “RF transaction device”. The Examiner also stated that it is not clear how the first and second data sets are associated with the transaction device before an interaction device communicates with the transaction device and provides the first and second data sets to the transaction device. Initially, Claim 14 has been amended to uniformly recite “RF transaction device” throughout the claim. Further, Claim 14 relates to a data management system comprising an RF transaction device and an interaction device.

Claim 14 also describes a way in which the components interact with each other. Applicants believe that the order of the components has no particular significance. For instance, it is well established that the steps in a method claim are not limited to the order of the steps, unless the claim explicitly says so. Thus it follows that the components in a system claim are not limited to the order of the components. Moreover, a person having ordinary skill in the art would understand the manner the components interact with each

other notwithstanding the order of the components. Accordingly, Applicants respectfully request that this claim rejection be withdrawn.

The Examiner stated that the recitation of the phrase “issuance of the RF transaction device by an issuer” renders the claim indefinite because it is not clear who the issuer is. The recitation of the phrase “by an issuer” has been removed from Claim 2. Applicants believe that the scope of the claim should not be limited to who the issuer is. The issuer may, for example, be the first data set owner, the second data set owner, or a third party who is not a data set owner. *See e.g.*, specification paragraphs [0024], [0025], and [0043]. Accordingly, Applicants respectfully request that this claim rejection be withdrawn.

The Examiner also stated that the recitations of “without the involvement of an issuer of the RF transaction device” in Claim 9 and “without involvement of an issuer of the RF transaction device” in Claim 14 render the claims indefinite because it is unclear who the issuer is. Claim 9 has been amended to recite “without involving any other data set owner” and Claim 14 has been amended to recite “without involving said first data set owner”. Applicants believe that the amendments to Claims 9 and 14 overcome these rejections and therefore, respectfully request that these claim rejections be withdrawn.

Claim Objections

Claim 4 was objected to for having an improper dependency. Claim 4 has been amended to depend from Claim 1. Applicants believe that this objection has been overcome and therefore, respectfully request the withdrawal of this objection.

Prior Art Rejections

Claims 1-5 and 7-15 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,480,100 (“Frieden”). Even though the Examiner did not state that Claim 16 was rejected under 35 U.S.C. § 102(e) as being anticipated by Frieden, Applicants note that the Examiner discussed Claim 16 with respect to Frieden (*see* Office Action, page 8, line 16 to page 9, line 7) and therefore, assume that the Examiner made such rejection.

Applicants note that Claim 6 was not rejected under 35 U.S.C. § 102(e) as being anticipated by Frieden. Therefore, Applicants assume that the Examiner deems Claim 6 to be patentable over Frieden.²

Frieden relates to methods for using an RFID tag associated with a component, and for organizing and storing data on the RFID tag in a user selected format. *See Abstract* and *see generally* column 2, line 63, to column 3, line 6. The selected format may be recorded or stored remote to the tag with a data format name. The data format name may be stored on the RFID tag, such that a tag interrogator retrieving the data format name from the tag may thereafter retrieve and/or load the corresponding data format to property parse and interpret the data stored on the tag in that format. *See generally* column 3, lines 7-24. The methods also include providing more than one data format on a particular tag, wherein each data format is defined by a corresponding user of a particular portion of the tag. *See generally* column 3, lines 29-33 and 62-67. Thus, a tag may include

² Should the Examiner disagree with Applicants’ assumption, he is respectfully requested to provide the reasons for the rejection of Claim 6. Of course, should such a rejection be made in the next Office Action, that Office Action must be made non-final.

multiple formats to meet the data storage needs of multiple users of a tag. However, Frieden does not teach or suggest “adding a condition header to at least one of said first and second data sets, said condition header identifies a status condition of said at least one of said first and second data sets,” as recited in Claim 1.

The Examiner equates the condition header recited in Claim 1 with the header format of Frieden. *See* Office Action, page 7, lines 15-16. Applicants respectfully disagree. The condition header of the present invention may include, for example, an indication of the status of the data set or and identifier correlated to a specific issuer or owner of the data. *See* specification paragraph [0056]. The condition header of the present invention may identify status condition of a data set, for example, add, loaded, initialized, ready, blocked, active, and inactive. *See e.g.*, specification paragraph [0056].

On the other hand, the header format of Frieden, as defined in the specification of Frieden, is the “layout or arrangement of the header blocks, and may include the size and location of each header block.” *See* Frieden, column 5, lines 24-26. Header block “may include all or a sub-divided portion of the memory/storage capacity of the RFID tag. Each header block may be formatted according to a separate, corresponding header format.” *See* Frieden, column 5, lines 20-23. Thus, the header format of Frieden is merely the layout or arrangement of a portion of the memory/storage capacity of the RFID tag. The header format of Frieden does not identify the status condition of a data set. Applicants submit that the header format of Frieden is not similar to the condition header of the present invention. Accordingly, Frieden does not have the claimed element.

For at least the reason stated above, Applicants submit that Claim 1 is patentable over Frieden.

Independent Claims 10 and 14 recite features similar to those discussed above with respect to Claim 1 and are therefore also believed to be patentable over Frieden.

Claims 17-19

Claims 17-19 depend from Claims 1, 10, and 14, respectively. Support for the new claims can be found in the specification, for example, in paragraph [0052].

Frieden, as understood by Applicants, does not teach or suggest enrolling a first data set owner and a second data set owner in a multiple account management program, “wherein said enrollment of said first data set owner and said second data set owner authorizes said adding of said first data set and said second data set to said database on said financial transaction instrument,” as recited in Claim 17. Accordingly, Applicants submit that Claim 17 is patentable over Frieden.

Claims 18 and 19 recite features similar to those discussed above with respect to Claim 17 and are therefore also believed to be patentable over Frieden.

The Remaining Claims

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional

aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


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